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In the
Supreme Court of the United States.

OCTOBER TERM, 1944.

No. 1161.

WENDELL J. CALEY,
Petitioner,

v.

RYAN DISTRIBUTING CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.

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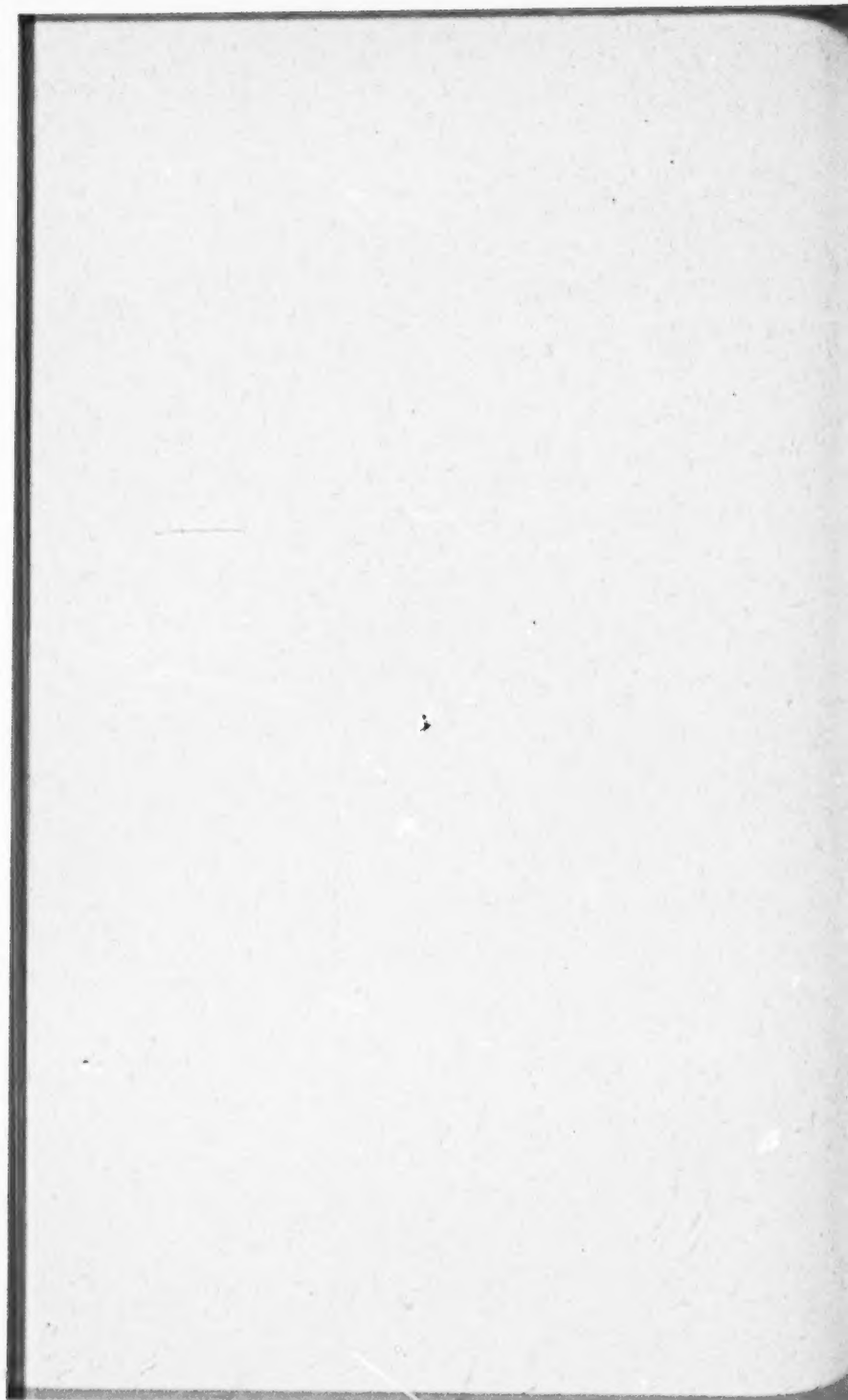


TABLE OF CONTENTS.

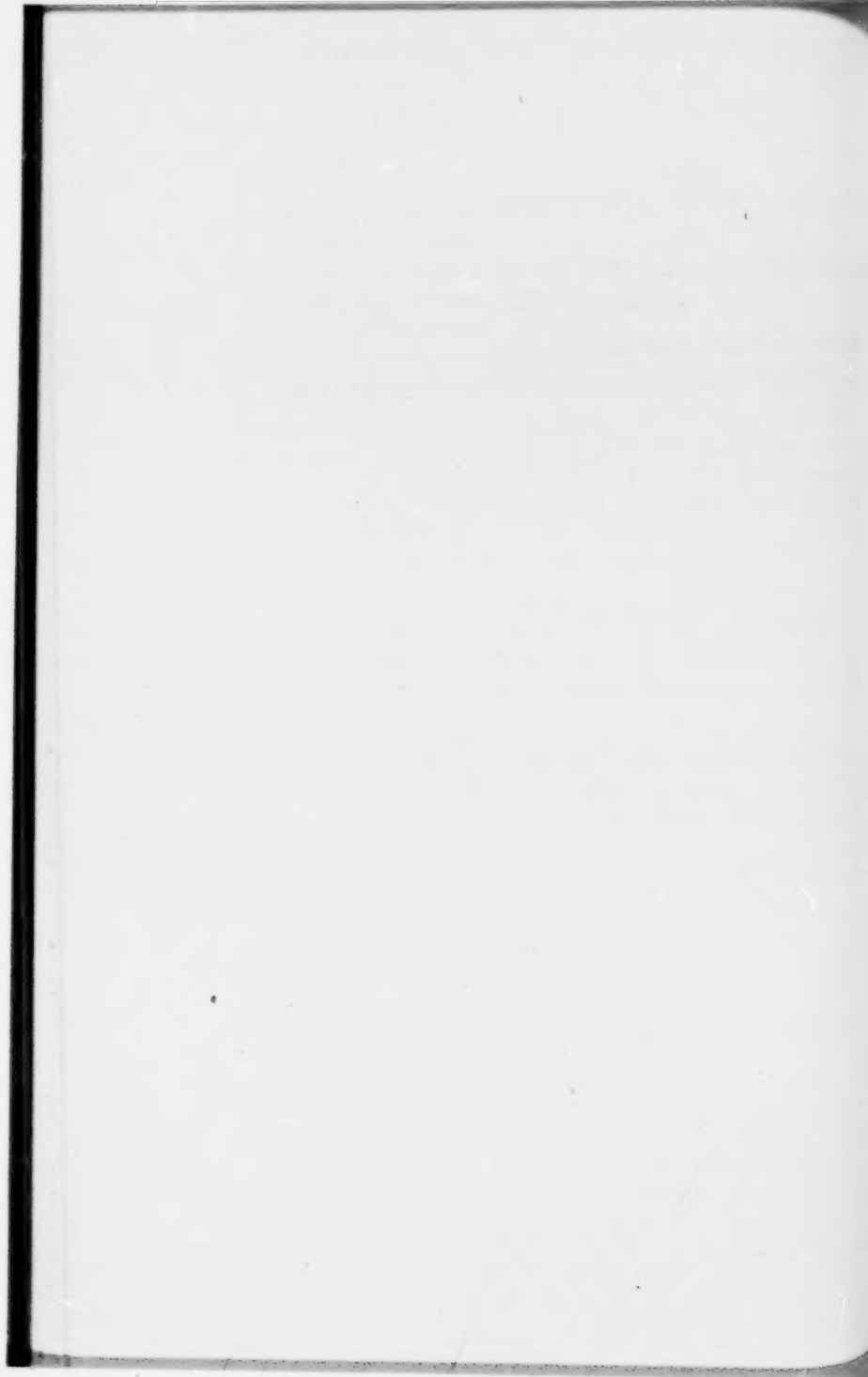
	Page
I. Statement of the Case	1
II. Petitioner's Evidence Allegedly Supporting Invention	4
1. The presumption of validity of the Caley patent arising from its grant by the Patent Office	4
2. The fact that Caley's Hair Curler has enjoyed commercial success	5
3. The opinion of Petitioner's expert that the Caley patent was valid and that Caley's changes constituted invention	6
4. The economy and speed resulting from the production of the Caley Hair Curler, in being stamped out from a large sheet of rubber, rather than individually molded	6
5. The fact that Mrs. Ryan, Respondent's Treasurer, once worked for the Respondent Caley	6
6. The fact that Respondent made an admittedly infringing curler when it could have made a non-infringing curler	6
7. The fact that Mrs. Ryan, Respondent's Treasurer, applied for a patent of her own somewhat similar to Caley's	7
III. Alleged Denial of Right to Jury Trial	8
Conclusion	8

TABLE OF CASES CITED.

Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654 (1935) ..	8
Black Diamond Co. v. Excelsior Co., 156 U.S. 611 at 618 (1894) ..	4
Brothers v. Lidgerwood Mfg. Co., 223 Fed. 359 (C.C.A. 2, 1915) ..	4
Cochrane v. Deener, 94 U.S. 780 at 784 (1876)	4
Connors v. Ormsby, 148 Fed. 13 (C.C.A. 1, 1906)	4, 5
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84 at 90 (1941)	3
De Forest Radio Co. v. General Electric Co., 283 U.S. 664 at 685 (1931)	5

	Page
Del Vecchio v. Bowers, 296 U.S. 280 at 286-7 (1935)	5
Farmers' Cooperative Exchange, Inc. v. Turnbow, 111 F. 2d 728 and 731 (C.C.A. 9, 1940)	6
Floridin Co. v. Attapulugus Clay Co., 125 F. 2d 669 (C.C.A. 3, 1942) ..	7
Fond du Lac County v. May, 137 U.S. 395 at 402-7 (1890)	4
Fowler v. Honorbilt Products, 131 F. 2d 153 (C.C.A. 3, 1942)	7
Galloway v. United States, 319 U.S. 372, 389 (1942)	8
Gunning v. Cooley, 281 U.S. 90 at 93-95 (1929)	4
Haughey v. Lee, 151 U.S. 282, 285 (1893)	7
Heald v. Rice, 104 U.S. 737 at 749 (1881)	4
International Steel Wall Corp. v. Williams Co., 137 F. 2d 342 at 343 (C.C.A. 6, 1943)	7
Luten v. Kansas City Bridge Co., 285 Fed. 840 at 844 (C.C.A. 8, 1922)	5
Market Street Railway Co. v. Rowley, 155 U.S. 621 at 625 (1894) ..	4
Montgomery Ward & Co. v. Duncan, 311 U.S. 243 (1940)	8
New York Life Insurance Co. v. Gamer, 303 U.S. 161 at 171-2 (1937)	5
Overweight Elevator Co. v. Improved Order of Red Men's Hall Ass'n., 94 Fed. 155 (C.C.A. 9, 1899)	6
Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464, 476-7 (1935)	6, 7
Pfanstiehl Chemical Co. v. American Platinum Works, 135 F. 2d 171 at 173 (C.C.A. 3, 1943)	6
Randall v. Baltimore & Ohio R.R. Co., 109 U.S. 478 (1883)	4
Reliance Life Ins. Co. v. Burgess, 112 F. 2d 234 at 238 (C.C.A. 8, 1940)	5
Risdon Iron & Locomotive Works v. Medart, 158 U.S. 68 at 83, 84 (1894)	6
Singer Mfg. Co. v. Cramer, 192 U.S. 265 (1903)	4
Slocum v. New York Life Ins. Co., 228 U.S. 364-369 (1912)	8
Textile Machine Works v. Louis Hirsch Textile Machines, 302 U.S. 490 at 498 (1937)	3

	Page
Toledo Pressed Steel Co. v. Standard Parts Co., 307 U.S. 350 at 355-6 (1938)	3
In re Wood-Paper Patent, 23 Wall. 566 (1873)	6
<hr/>	
Federal Rules of Civil Procedure, Rule 50b	8
Model Code of Evidence—American Law Institute, Rule 704 (1 and 2)	5
Wigmore on Evidence (3rd Ed.) Sec. 2491, pp. 289-291	5
Walker on Patents (Deller's Ed.) Sec. 44, pp. 234-236, 241	5
Walker on Patents (Deller's Ed.) page 1211	6



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RESPONDENT.**

**BRIEF FOR RESPONDENT IN OPPOSITION TO
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I. STATEMENT OF THE CASE.

The facts and issues presented in this case are clearly and adequately stated by the Circuit Court of Appeals in its Opinion (R. pp. 54a-59a). The situation, briefly, was this:

Respondent Ryan Distributing Corporation brought an action against Petitioner Caley for a declaratory judgment that Caley patent No. 1,945,932 for a Hair Curler or Waver was invalid or not infringed. Caley counterclaimed for infringement of his patent, but limited his demand to damages, and demanded a jury trial on the issues raised by the Complaint and counterclaim. Respondent's Motion to Strike the Demand for Jury Trial, or in the alternative for Separate Trial on the complaint, was denied (R. pp. 4a-8a). The case was then tried before a jury, the District Court denying Respondent's Motion for Directed Verdict,

and the jury found the patent valid and infringed. The District Court then granted Respondent's Motion to Set Aside the Verdict, and judgment was entered finding the Caley patent invalid. The Court of Appeals affirmed.

The sole issue before the Court of Appeals was whether there was sufficient evidence in the case to support the jury's verdict of validity of the Caley patent. Secondly, the case involves the determination of the nature of the evidence necessary to support a finding of invention, as contrasted with the proofs of prior art practices which establish non-invention.

The device of the Caley patent, a Hair Curler or Waver, is extremely simple. As the Caley patent drawings (R. p. 49a) show, it comprises a flat strip of rubber or similar flexible material, having an elongated eye or slot at one end, and a notched head at the other end adapted to pass through the eye in quarter-turned (or 90°) position and to lock against the strip when turned to normal position.

An admittedly prior art construction is shown in Figs. 8 and 9 of the Caley patent (R. p. 49a) and comprised a similar flexible strip of rubber with a *circular* eye at one end and a *spherical* knob at the other end adapted to pass through the eye and to be locked therein. The reason for making Caley's change was "to make the buttoning of the head and eye ends together more easy by providing the head with flatness whereby the head may be inserted edgewise through the eye and then buttoned by turning back into its normal plane." (Caley patent, R. p. 50a, 11. 21-26.) The Caley curler, being stamped from sheet material, could also be made more cheaply than the prior molded rubber curler of Caley's Figs. 8 and 9.

Such a slight change of shape and form from the prior art is obviously within the competence of any skilled person and not invention. The Caley patent obviously does not

meet the standard of invention required by the decisions of this Court.

Cuno Engineering Corp. v. Automatic Devices Corp.,
314 U.S. 84 at 90 (1941).

Toledo Pressed Steel Co. v. Standard Parts Co., 307
U.S. 350 at 355-6 (1938).

Textile Machine Works v. Louis Hirsch Textile Ma-
chines, 302 U.S. 490 (1937).

Respondent's evidence establishing invalidity of the Caley patent for lack of invention consisted of the Caley patent itself, the file history of the Caley patent in the Patent Office, and a Book of Prior Art Patents. Except for the Caley patent, this evidence is not reproduced by Petitioner in the Transcript of Record before this Court, but the prior art patents are described in the Opinion of the Court of Appeals (R. p. 56a), and the Caley patent alone, with its showing of an admittedly prior construction, is sufficient to establish its own invalidity.

The Caley patent was obviously invalid for lack of invention. But the jury had found it valid and infringed. In that situation the District Court (Judge Kirkpatrick) very properly granted Respondent's Motion to Set Aside the Verdict, saying (R. p. 44a):

"It seems to me that it is so plain that invention does not exist, that it is the duty of the Court to so declare and the Court should have so instructed the jury."

The District Court acted according to the established rule that, when it is clearly apparent merely from the disclosure of the printed prior art that invention does not exist, and there are no disputed questions of facts depending upon the credibility of witnesses, then the question of existence of invention is determined by the Court as a matter of law.

Market Street Railway Co. v. Rowley, 155 U.S. 61 at 625 (1894).

Singer Manufacturing Co. v. Cramer, 192 U.S. 201 (1903).

Randall v. Baltimore & Ohio R. R. Co., 109 U.S. 475 (1883).

Brothers v. Lidgerwood Mfg. Co., 223 Fed. 301 (C.C.A. 2, 1915).

Connors v. Ormsby, 148 Fed. 13 (C.C.A. 1, 1906).

Fond du Lac County v. May, 137 U.S. 395 at 402 (1890).

Heald v. Rice, 104 U.S. 737 at 749 (1881).

Cochrane v. Deener, 94 U.S. 780 at 784 (1876).

Black Diamond Co. v. Excelsior Co., 156 U.S. 611 at 618 (1894).

Gunning v. Cooley, 281 U.S. 90 at 93-95 (1929).

As the Court of Appeals said in affirming (R. p. 55a):

"The Caley patent and those of the prior art are so extremely simple as to speak for themselves, so that the Court could determine from mere comparison what was the claimed invention described in each, and then decide from such comparison whether the articles described were or were not substantially the same."

II. PETITIONER'S EVIDENCE ALLEGEDLY SUPPORTING INVENTION.

Petitioner's evidence relied on to support the jury's verdict of validity was obviously wholly insufficient for that purpose, or to overcome Respondent's proofs conclusively establishing the invalidity of Caley's patent for lack of invention. Petitioner's evidence consisted of such as the following:

1. *The presumption of validity of the Caley patent arising from its grant by the Patent Office.* A presumption, or

course, has no weight as evidence itself, but is merely a rule of procedure imposing on the party against whom it operates, the duty of coming forward with evidence, and when that presumption is met by evidence to the contrary, the presumption disappears. Here Respondent fully rebutted the starting presumption of validity by conclusive proof of the patent's invalidity, as shown by the prior art patents, and Petitioner's starting presumption could not then be given weight as evidence in determining Petitioner's right to go to the jury.

New York Life Insurance Co. v. Gamer, 303 U.S. 161 at 171-2 (1937).

Connors v. Ormsby, 148 F. 13 at 14 (C.C.A. 1, 1906).

Luten v. Kansas City Bridge Co., 285 F. 840, 844 (C.C.A. 8, 1922).

Del Vecchio v. Bowers, 296 U.S. 280 at 286-7 (1935).

Reliance Life Ins. Co. v. Burgess, 112 F. (2d) 234 at 238 (C.C.A. 8, 1940).

Wigmore on Evidence (3rd Ed.) Sec. 2491 pp. 289-291.

Model Code of Evidence—*American Law Institute*, Rule 704 (1 and 2).

2. *The fact that Caley's Hair Curler has enjoyed commercial success.* When a patented device plainly lacks invention over the prior art, commercial success is, of course, wholly incapable of supplying patentability.

Textile Machine Works v. Louis Hirsch Textile Machines, 302 U.S. 490 at 498 (1937).

De Forest Radio Co. v. General Electric Co., 283 U.S. 664, 685 (1931).

Walker on Patents (Deller's Ed.) Sec. 44, pp. 234-236 and 241.

3. *The opinion of Petitioner's expert that the Caley pat-*

ent was valid and that Caley's changes constituted invention. A court or jury, of course, is not obliged to follow the conclusions of an expert and may disregard them, if they are unsound, or unreasonable, or unsupported by the evidence.

Walker on Patents (Deller's Ed.) p. 1211.

Overweight Elevator Co. v. Improved Order of Red Men's Hall Ass'n., 94 F. 155 (C.C.A. 9, 1899).

Farmers' Cooperative Exchange, Inc. v. Turnbourn, 111 F. (2d) 728 and 731 (C.C.A. 9, 1940).

4. *The economy and speed resulting from the production of the Caley Hair Curler, in being stamped out from a large sheet of rubber, rather than individually molded.* Even though the hair curler may be the product of a cheaper process of manufacture, that does not make the hair curler itself a new article of manufacture and hence patentable.

In Re Wood-Paper Patent, 23 Wall. 566 (1873).

Risdon Iron & Locomotive Works v. Medart, 158 U.S. 68, 83, 84 (1895).

Pfanzstiel Chemical Co. v. American Platinum Works, 135 F. 2d 171 at 173 (C.C.A. 3, 1943).

5. *The fact that Mrs. Ryan, Respondent's Treasurer, once worked for the Petitioner Caley.* Such a fact, of course, is wholly immaterial in a patent infringement suit where the patentee's rights are dependent upon the validity of his own patent and its contribution to the art.

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464, 476-7 (1935).

6. *The fact that Respondent made an admittedly infringing curler when it could have made a non-infringing curler.* Infringement is evidence of utility, but not of invention. In fact, infringement is more likely evidence of non-invention

where, as here, Respondent infringes the patent because convinced that the patent is invalid for lack of invention and was improperly granted by the Patent Office.

7. *The fact that Mrs. Ryan, Respondent's Treasurer, applied for a patent of her own somewhat similar to Caley's.* Such alleged estoppel by conduct obviously yields to the paramount public interest against the allowance of invalid patents.

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464, 476-7, (1935).

Haughey v. Lee, 151 U.S. 282, 285 (1893).

Fowler v. Honorbilt Products, 131 F. 2d 153 (C.C.A. 3, 1942).

Floridian Co. v. Attapulugus Clay Co., 125 F. (2d) 669 (C.C.A. 2, 1942).

International Steel Wall Corp. v. Williams Co., 137 F. 2d 342 at 343 (C.C.A. 6, 1943).

The Court of Appeals thus correctly summarized the situation, we submit (R. p. 58a):

"The grant of the patent, the public acceptance of the article, its copying by plaintiff, plaintiff's seeking an improvement patent thereon, economy of production, expert testimony to the effect that it was not obvious to those skilled in the art, these are all evidence tending to show invention. But they do not conclusively indicate invention as defendant urges. Such evidence, when doubt exists, may resolve that doubt in favor of him who submits it, but where as here there is a clear-cut case of lack of invention such evidence cannot successfully controvert it."

III. ALLEGED DENIAL OF RIGHT TO JURY TRIAL

Petitioner finally argues that the action of the District Court in setting aside the jury's verdict of validity deprives Petitioner of his right to a jury trial guaranteed by the Seventh Amendment of the Federal Constitution. The contention is obviously unsound.

Galloway v. United States, 319 U.S. 372, 389 (1942).
Slocum v. New York Life Ins. Co., 228 U.S. 364-369 (1912).

Baltimore & Carolina Line Inc. v. Redman, 295 U.S. 654 (1934).

Rule 50b, Federal Rules of Civil Procedure.

Montgomery Ward & Co. v. Duncan, 311 U.S. 243 (1940).

CONCLUSION.

We respectfully submit that the action of the District Court in setting aside the jury's verdict and entering judgment for Respondent, and the judgment of the Circuit Court of Appeals affirming the District Court, was correct and fully supported by the evidence of record herein, that the Petition presents no question requiring the exercise of this Court's discretionary jurisdiction, and should be denied.

Respectfully submitted,

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May 2, 1945.

